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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,398	12/21/2001	Ishita Majumdar	CE08806R	1163

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EXAMINER

LIM, KRISNA

ART UNIT PAPER NUMBER

2153

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,398

Applicant(s)

MAJUMDAR ET AL.

Examiner

Krisna Lim

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. Claims 1-11 are presented for examination.
2. Claims 1-2 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a) In claim 1, it is unclear from where a full message is received. It is unclear how static and default dictionaries from the information. In line 3, "a full message" is unclear. Does this full message the same as "a full message" in line 1? In line 4, "the message" lacks clear antecedent basis. In line 8, "the compressed message" lacks clear antecedent basis.
 - b) In claim 2, line 2, "a URL" should be "the URL". At last line, "the message" lacks clear antecedent basis.
 - c) In claim 3, it contains similar problems as in claim 2.
 - d) In claim 4, "the compressed SIP message" lack clear antecedent basis. Moreover, the acronym of "SIP" is not known.
 - e) In claim 5, it is unclear how a full message is generated. It is unclear how static and default dictionaries from the information. In line 4, "a full message" is unclear. Does this full message the same as "a full message" in line 1? In line 8, "the compressed message" lacks clear antecedent basis; and
 - f) As to claims 6-11, they contain similar problems as in claims 1-5.
3. It is requested that a future correspondence from applicants have line numbering for the recitation of claims, if possible, as this will aid in the future correspondence from the examiner.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-9 are rejected under 35 U.S.C. §102(b) as being anticipated by Mitzenmacher et al. [U.S. Patent No. 5,953,503].

6. Mitzenmacher et al. anticipate (e.g., see Figs. 1-3) the invention substantially as claimed. Taking claim 1 as an exemplary claim, the reference anticipates a method of generating a compressed message from a full message comprising the step of:

- a) receiving the full message (e.g., see col. 2 (lines 52-57), col. 4 (lines 47-50);
- b) retrieving a URL in a field of the message (e.g. see col. 4 (lines 55-56), col. 3 (line 38));
- c) obtaining information corresponding to the URL from a database (e.g., see col. 4 (lines 55-56), 320 of Fig. 3);
- d) building static and default dictionaries from the information (e.g., see 240 of Fig. 2, col. 3 (lines 5-20)); and
- e) generating a compressed message (e.g., see col. 2 (lines 58-60), col. 4 (line 50).

7. As to claims 2-3, the feature of retrieving the URL in the "To" and the "From" fields of the message is inherent in Web Browser, HTML page and e-mail, URL based HTTP protocol, header of the HTTP protocol and Web page (e.g., see col. 2 (line 55), col. 3 (lines 13 and 38), col. 4 (lines 55-57)).

8. As to claim 4, Mitzenmacher et al. anticipate the step of appending a context ID (e.g., a fingerprint 250 which uniquely identifies that dictionary is generated in step 260, col. 4 (lines 35-37)).

9. As to claims 5-9, they are rejected for the 1-4.

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 10-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitzenmacher et al. [U.S. Patent No. 5,953,503].

12. As to claims 10-11, they are similar to claims 1-5 above with the reverse functions. For example, claims 1-5 are dealing with the receiving of the full message and then generating the compressed message while claims 10-11 are dealing with the receiving the compressed message and producing the full message. It would have been obvious to one of ordinary skilled in the art at the time the invention to recognize that such reverse operation would have been a matter of reverse engineering because claims 10-11 are the reverse operations of claims 1-4. Moreover, Mitzenmacher et al. disclose the feature of using preset dictionaries to accomplish both the compression and de-compression of the messages (e.g., see col. 2, lines 58-60).

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956

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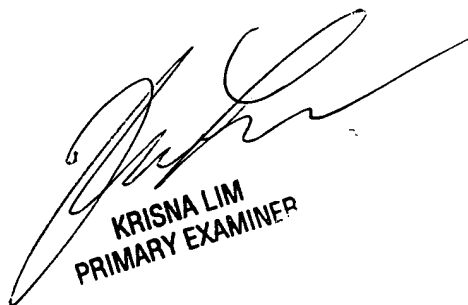
the examiner can normally be reached on Monday to Wednesday and Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

March 1, 2005



KRISNA LIM
PRIMARY EXAMINER